

REMARKS

Applicant respectfully requests entry and consideration of the above amendments even though presented after a final rejection. Applicant submits that the amendments do not raise new issues or require a new search. Further, entry and consideration of the amendments may isolate issues for potential allowance or appeal. The amendments were not presented earlier in the prosecution due to a better understanding of the Examiner's position as reflected in the latest Office Action.

Claims 1, 4, 5-7, 9, 12-21 stand in this application. Claims 2, 3, 8, 10 and 11 have been canceled without prejudice to the underlying subject matter contained therein. Claims 1, 7, 9, 12-15, 19 and 20 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Claims 1, 4, 5-7, 9, 12-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 5,619,247 (Russo) in view of USPN 4,945,563 (Horton). Applicant respectfully traverses the rejection, and respectfully requests reconsideration and removal of the rejection.

Applicant has cancelled claims 2, 3, 8, 10 and 11 and has incorporated their subject matter into claims 1, 7 and 19. Therefore, the obviousness rejection with respect to claims 2, 3, 8, 10 and 11 will be addressed below with respect to amended claims 1, 7 and 19.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish

a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1, 4, 5-7, 9, 12-21. Therefore claims 1, 4, 5-7, 9, 12-21 define over Russo and Horton, whether taken alone or in combination. For example, claim 1 as amended recites the following language, in relevant part:

a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content, and once stored, a length of time the playback device may reproduce the received broadcast content.

At least this language is not disclosed by Russo or Horton, whether taken alone or in combination.

Applicant submits that Russo fails to disclose the missing language of claim 1. As correctly noted in the Office Action, Russo fails to disclose control information embedded in broadcast content. Office Action, Page 3. Russo also fails to describe a “descriptor,” which is a data structure used to convey the control information and/or descriptive information. *See* Specification, Page 4, Lines 14-23, for example. It therefore follows, a fortiori, that Russo also fails to describe “a descriptor embedded in the received broadcast content” as recited in claim 1.

Further, Russo fails to describe “a length of time the playback device may reproduce the received broadcast content.” According to the Office Action, this language is disclosed by Russo at column 5, lines 32-46. At column 5, lines 32-46, Russo states, in relevant part, “a viewer may be allowed to view a selected program as many times as desired over a particular, predetermined period of time without incurring any additional charges.” This citation, however, fails to describe a “descriptor” in any context, let alone a descriptor to indicate “a length of time the playback device may reproduce the received broadcast content” as recited in claim 1.

In addition, Russo fails to describe “the descriptor to indicate whether the storage device may store the received broadcast content” as recited in claim 1. The Office Action was silent regarding whether Russo discloses this language, and instead refers the Applicant to Horton. It therefore follows that Russo also fails to disclose this language.

Horton also fails to disclose the missing language of claim 1. For example, Horton fails to disclose “a length of time the playback device may reproduce the received broadcast content” as recited in claim 1. This language was original recited in canceled claim 10. In addressing claim 10, the Office Action was silent regarding whether Horton

discloses this language, and instead refers the Applicant to Russo. Russo fails to disclose this language as previously discussed. Horton also fails to disclose this language since there is no discussion of managing viewing time.

For at least the reasons give above, Russo and Horton fail to disclose, teach or suggest every element recited in claim 1, whether taken alone or in combination.

Removal of the obviousness rejection for claim 1 is therefore respectfully requested.

Independent claims 7 and 19 recite features similar to those recited in claim 1. Therefore, for reasons analogous to those presented with respect to claim 1, Applicant respectfully submits that claims 7 and 19 are non-obvious over Russo and Horton, whether taken alone or in combination. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to these claims.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, removal of the obviousness rejection with respect to claims 4, 5-7, 9, 12-18, 20 and 21 is respectfully requested. Claims 4, 5-7, 9, 12-18, 20 and 21 also are non-obvious and patentable over Russo and Horton, taken alone or in combination, at least on the basis of their dependency from claims 1, 7 and 19. Applicant, therefore, respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

Claims 1, 4, 5-7, 9, 12-21 also are patentable and non-obvious over Russo in view of Horton, whether taken alone or in combination, because a rejection based on obviousness under 35 U.S.C. § 103(a) is improper without a motivation to combine the cited references. *See* MPEP § 2142, for example. Russo fails to discuss a “descriptor” in any context, let alone “a descriptor embedded in the received broadcast content, the

descriptor to indicate whether the storage device may store the received broadcast content, and once stored, a length of time the playback device may reproduce the received broadcast content” as recited in claim 1, for example. Therefore, Russo clearly fails to provide the proper motivation to make the combination alleged by the Office. Similarly, Horton fails to discuss “a length of time the playback device may reproduce the received broadcast content” in any context, let alone “a descriptor embedded in the received broadcast content” to provide such information. Therefore, Horton clearly fails to provide the proper motivation to combine. Furthermore, the Office does not set forth a clear line of reasoning or suggestion as to why it would have been desirable for a person of ordinary skill in the art to make the alleged combination of Russo and Hancock to arrive at the subject matter of the claimed subject matter.

For at least the above reasons, Applicant submits that claims 1, 4, 5-7, 9, 12-21 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action’s rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to

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be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

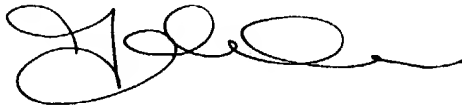
It is believed that claims 1, 4, 5-7, 9, 12-21 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

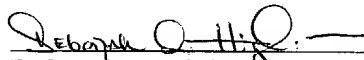
Respectfully submitted,

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Under 37 CFR 1.34(a)

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Deborah L. Higham

11-12-04
Date

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